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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,050

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Eng Tat Lim

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HOWREY LLP

C/O IP DOCKETING DEPARTMENT

2941 FAIRVIEW PARK DRIVE, SUITE 200

FALLS CHURCH, VA 22042-2924

EXAMINER

WONG, STEVEN B

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

09/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,050

Applicant(s)

LIM, ENG TAT

Examiner

Steven Wong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-27-2006</u> | 6) <input type="checkbox"/> Other: ____ |

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “15” (page 9, line 15 of the specification). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the leg portions for the stopper portion (claim 11) and the second position where the shaft, support portion and prong members are disposed substantially within the cavity (15) (claim 12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 12-15 and 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 12 defines a shaft (12) with a pivotable supporting portion (16) arranged atop the shaft (12). Claim 12 also states that the shaft (12) is pivotable relative to the base portion (13) and that the pivotable support portion (16) is pivotable relative to a longitudinal axis of the shaft (12). Thus, claim 12 implies that a pivotable connection exists between both the base portion and the shaft and the shaft and the support portion. This arrangement is not clearly defined in the specification. Basis for a pivotable connection in the originally filed specification only sets forth this connection between the shaft and the ball supporting portion.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase (3,414,268). Regarding claim 1, Chase discloses a golf tee construction (note Figure 4) comprising a shaft (12) for insertion into the ground, a pivotable support portion (118) mounted atop of the shaft and a plurality of upright prong members (17) mounted on the support portion. Note Figure 5 showing a golf ball atop the prong members.

Regarding claims 2-4, note Figure 4 showing a pivotable connection means (21, 11C) between the shaft and the support portion.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268) in view of Morabeto (4,645,208). Regarding claim 5, Morabeto disclose a golf tee construction comprising a shaft portion (1) and a support portion (6). The shaft and support portions are pivotably connected by a ball and socket assembly (note Figure 5). It would have

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been obvious to one of ordinary skill in the art to modify the golf tee of Chase so that the support portion provides the ball and the shaft provides the socket in order to provide an alternative arrangement that permits the pivotable movement.

Regarding claim 7, Morabeto provides a stopper portion on his shaft. It would have been obvious to one of ordinary skill in the art to provide the shaft of Chase with a stopper portion in order to have the user insert the tee into the ground at a particular height.

Regarding claims 8 and 9, Morabeto provides a downwardly sloping surface. It would have been obvious to one of ordinary skill in the art to provide a downwardly sloping surface with a gradient of 25 degrees as the applicant has not stated the particular criticality for this angle and it appears that the angle of Morabeto would accomplish similar purposes.

Regarding claim 10, note Figures 1 and 2 of Morabeto showing markers (4) that are disposed diametrically opposite the sloping surface (3). The markers are obviously capable of being used as guidance markers.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268) in view of Morabeto (4,645,208) and Liu (US 2004/0018896). Liu discloses that it is well known in the art of golf tees to form the shaft of the tee from two portions (20, 30) so that the tee may be separated to provide a short golf tee and a longer golf tee. It would have been obvious to one of ordinary skill in the art to provide a threaded connection for the shaft of the golf tee of Chase in order to permit the user to remove the pivotable section and use the tee as a short golf tee.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268) in view of Morabeto (4,645,208) and Lewis et al. (5,571,055). Lewis discloses a

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golf tee construction including stoppers (20) mounted on the tee shaft for limiting the depth that the tee may be inserted into the ground. Further, Lewis provides spines (18) extending from the bottom surface of the stopper for support purposes. It would have been obvious to one of ordinary skill in the art to provide the stopper of Chase as modified by Morabeto with a plurality of legs in order to support the stopper portion to prevent breakage.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268) in view of St. John (GB 2,258,161). Regarding claim 16, the prong members of Chase are equidistantly and equiangularly arranged upon the support portion.

St. John reveals that it is well known in the art of golf tees to provide a plurality of prong members such that the prongs provide minimal contact with the golf ball. It would have been obvious to one of ordinary skill in the art to replace the prong members of Chase with those of St. John in order to provide an alternative method for supporting the golf ball on the tee.

12. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268). Regarding claim 17, the longitudinal lengths of Chase are substantially the same.

Regarding claim 18, the prong members of Chase are obviously capable of being varied to suit a particular intended golf stroke.

13. Claims 12-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jewett (2,198,968) in view of Cardarelli (D488,525). Regarding claim 12, Jewett discloses a golf teeing device comprising a base portion (12) having a cavity (40) and at least one shaft (20) having a pivotable support portion (36). The shaft (20) is also pivotable relative to the base portion between a first position (where the tee is arranged to support a golf ball placed atop the tee (dotted line positioning as shown in Figure 1) and a second position where the shaft, support

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portion and tee are disposed within the cavity (where the shaft is positioned to receive a golf ball from pipe (31)). However, Jewett lacks the teaching for the tee to comprise a plurality of prong members.

Cardarelli reveals that it is well known in the art of golf tees to form the tee with a plurality of prong members. It would have been obvious to one of ordinary skill in the art to replace the tee of Jewett with a plurality of prong members as taught by Cardarelli in order to reduce the contact friction between the tee and the ball.

Regarding claims 13-15, Cardarelli teaches for the tee to comprise three prong members. Further, the prongs are seen as presenting a pointed portion (edge of the tip of the prong). Further, the prongs are substantially conical. In the alternative, it would have been obvious to one of ordinary skill in the art to form the ends of the prongs as pointed conical members in order to further limit the frictional contact between the tee and the golf ball.

Regarding claims 19 and 20, Jewett provides a substantially horizontal upper surface (noted generally at 12 in Figure 1) and a downwardly sloping surface (40). The downwardly extending surface extending around the cavity and thus will obviously be facing towards a striking surface of a golf club. It would have been obvious to one of ordinary skill in the art to have the angle of the sloping surface bet about 25 degrees as the applicant has not stated the criticality for this particular angle by a new and unexpected result obtained therefrom.


Regarding claim 21, it would have been obvious to one of ordinary skill in the art to provide three of the devices of Jewett next to one another in order to permit multiple users to be play at the same time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
September 10, 2007